

regard as the invention. Applicants respectfully traverse this rejection for at least the reasons detailed below.

One requirement of 35 U.S.C. § 112, second paragraph, is the objective determination of "whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art." M.P.E.P. § 2171, 8<sup>th</sup> ed., August 2001. Applicants respectfully submit that their claims meet this standard for at least the reasons set forth below. Accordingly, Applicants respectfully request withdrawal of this rejection under § 112, second paragraph.

According to the Examiner, claims 1-41 are indefinite for using the term "polyacrylamide-based." (Office Action dated August 15, 2001, page 2, lines 9-10.) Applicants, however, have defined this term in the specification using language that would be clearly understood by one of ordinary skill in the art. For example, the specification provides that "the polyacrylamide polymer can, aside from being polyacrylamide itself, be a derivative thereof, and can be a mixture of a plurality of types of polymers, and can also be a copolymer with acrylamide and its derivatives as monomers." (Specification, page 7, lines 13-16.) Further, Applicants provide that the "polyacrylamide-based polymer can, for example, have a number average molecular weight of approximately 1000-1,000,000." (Specification, page 7, lines 12-13.) Because Applicants have clearly defined this term, and consequently the metes and bounds of the claimed invention, the rejection under § 112, second paragraph, is improper. Accordingly, Applicants respectfully request withdrawal of this rejection.

III. Rejection Under 35 U.S.C. § 102(a)

Claims 1, 5, 23-26, 35, 37, 40, and 41 have been rejected as anticipated by Japanese Application No. JP 11 - 021227 to *Takeshi* ("*Takeshi*") under 35 U.S.C. § 102(a) for the reasons set forth on page 2 of the present Office Action. Specifically, the Examiner asserts that *Takeshi* anticipates the above claims because the reference allegedly "meet[s] the limitations of the claims." (Office Action dated August 15, 2001, page 2, lines 21-22.) Applicants disagree and respectfully traverse this rejection for at least the reasons set forth below.

For a reference to successfully anticipate the present claims, "[t]he identical invention must be shown in as complete detail as is contained in the patent claim." *Richardson v. Suzuki Motor Co.*, 868 F. 2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). *Takeshi* does not fulfill this requirement.

Claim 1 of the present invention recites, among other things, "at least one ingredient chosen from pigments and fillers, wherein the at least one ingredient has been surface-treated by at least one water-repellant and oil-repellant agent." *Takeshi* does not teach this aspect of Applicants' claims. As the Examiner herself points out, "[t]he JP reference in the abstract form does not show the presence of pigments in the gel composition." (Office Action dated August 15, 2001, page 3, lines 14-15.) Applicants agree. Additionally, for the Examiner's convenience, Applicants have provided an English-language translation of *Takeshi*, submitted by way of an Information Disclosure Statement filed concurrently with this Reply. The translation provides that pigments and fillers may be used in *Takeshi's* compositions (Paragraph 0019), and Example 4 of the translation recites talc, titanium oxide, mica, and iron

oxide. *Takeshi*, however, does not teach the at least one ingredient chosen from pigments and fillers, wherein the at least one ingredient has been surface treated by at least one water-repellant and oil-repellant agent. Because these elements are not taught by the cited reference, there can be no anticipation. Accordingly, Applicants respectfully request withdrawal of this rejection.

**IV. Rejection Under 35 U.S.C. § 103**

In the outstanding Office Action, the Examiner has rejected claims 1-41 under 35 U.S.C. § 103(a) as unpatentable over *Takeshi* and U.S. Patent No. 5,567,420 to *McEleney et al.* ("*McEleney*"). Applicants respectfully traverse this rejection for at least the following reasons.

To establish a *prima facie* case of obviousness, the Examiner bears the burden of establishing *at least* that the cited references teach or suggest all of the claim limitations. M.P.E.P. § 2143. Neither *Takeshi* nor the combination of *Takeshi* with *McEleney* teaches all of the limitations of Applicants' claims.

The Examiner alleges that the "combined teachings" of the references is proper because "[o]ne having ordinary skill in the art would have been motivated to prepare a composition comprising polyacrylamide, non-ionic surfactant, pigments, petrolatum, vaseline or ceresin, organopolysiloxane, preservatives and sunscreens agents." See, Office Action at page 4, lines 3-5. Applicants submit that there is no such motivation to combine the two references cited. Even if the references were properly combinable, the combination would not teach all of Applicants' claim limitations as the Examiner alleges.

For example, neither reference, nor the reference combination, teaches Applicants' "at least one ingredient chosen from pigments and fillers, wherein the at least one ingredient has been surface-treated by at least one water-repellant and oil-repellant agent." As discussed above with respect to the anticipation rejection, *Takeshi* does not disclose pigments or fillers, let alone surface-treated pigments and fillers.

Likewise, *McEleney* does not fill this void. For example, *McEleney* concerns color indicators, which are present in the compositions to provide visible color upon application to the skin, but which change or become clear (colorless) after application. (*McEleney*, col. 2, lines 2-14.) These color indicators include naturally occurring and synthetic derivatives of pH indicators. (*McEleney*, col. 1, lines 61-63.) Examples of such color indicators include phenolphthalein,  $\sigma$ -cresolphthalein, thymolphthalein, quinazolinedione, and ethyl-bis ethanoate. (*McEleney*, col. 3, lines 5-7.) These color indicators are not Applicants' pigments and fillers, which are surface-treated by at least one water-repellant and oil-repellant agent.

Further, the disclosures of *McEleney* cited by the Examiner, for example, column 5, lines 3-8 and claim 10, do not disclose pigments or fillers that are surface-treated by at least one water-repellant and oil-repellant agent. Thus, neither reference nor the reference combination teaches all of Applicants' claim limitations.

Accordingly, Applicants respectfully submit that no *prima facie* case of obviousness has been established by the cited reference or cited reference combination. Respectfully, Applicants request that this rejection be withdrawn.

V. Examiner's Observation

Applicants thank the Examiner for her observation with respect to the dependency of claim 10. Applicants note, however, that proper antecedent basis for claim 10 can be found either in claim 7 or in claim 8, which depends from claim 7. Accordingly, Applicants choose to have claim 10 depend from claim 8, not claim 7.

VI. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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